

REMARKS

By the present amendment, claim 1 has been amended to recite that the protective film is has an outer surface roughness Ra of from 0.05 to 1  $\mu\text{m}$ , and claim 5 has been amended to recite that the separator can be released from the optical material. Further, new claims 27-31 have been added. Support for the added recitations is found in the original application, in particular on page 16, third paragraph and in the Examples (claims 1 and 27-31) and on page 13, second paragraph (claim 5).

Claims 1-31 are pending in the application. Claims 1, 5, 17, and 24 are the only independent claims.

Claims 17-26 have been withdrawn from consideration following an election/restriction requirement, but an indication regarding the genericness of claim 5 was made in the previous Office Action.

In this Office Action, claims 5-8 and 13-16 are rejected under 35 U.S.C. 102(b) as anticipated by JP 10-319233 to Nakajima et al. (Nakajima).

The rejection is respectfully traversed. The surface-roughened film 5 of Nakajima is a light diffusion layer, i.e., an optical layer which is bonded permanently, and not a provisional protection film. In contrast, in the optical member of present claim 5, the adhesive layer disposed on an outermost surface of the optical material is provisionally bonded to and covered with a separator having an outer surface roughness Ra of at least 0.03  $\mu\text{m}$ , as recited in claim 5, i.e., the separator can be released from the optical material, as recited in present claim 5. This feature and its advantages are not taught or suggested in Nakajima, and therefore, present claims 5-8 and 13-16 are not anticipated by, and not obvious over, Nakajima.

In view of the above, it is submitted that the rejection should be withdrawn.

Next, in the Office Action, claims 1-3 and 9-12 are rejected under 35 U.S.C. 103(a) as obvious over WO 00/44841 to Nagahama et al. (Nagahama) in view of US 5,972,473 to Arakawa et al. (Arakawa), and claim 4 is rejected under 35 U.S.C. 103(a) as obvious over Nagahama and Arakawa, further in view of US 6,111,699 to Iwata et al. (Iwata). It is alleged in the Office Action that Nagahama teaches an optical element having a releasable protective film comprising a protective base and an adhesive layer, and Arakawa teaches a protective film having an outer surface roughness of at most  $\frac{1}{2}$  of the protective film thickness, i.e., 2-25 microns, so that it would have been obvious to use the surface roughness of Arakawa “for the purpose of reducing the friction coefficient of the surface of the film”.

Reconsideration and withdrawal of the rejections is respectfully requested. As a preliminary, it is submitted that a person of ordinary skill in the art in the optical field would not be motivated to refer to the teachings of Arakawa because Arakawa concerns non-optical materials, so that it provides no guidance as to the optical effects of the structures described therein. In particular, Arakawa is completely silent as to the optical effects of the surface roughness suggested for its separator. Therefore, for this reason alone, claims 1-4 and 9-12 are not obvious over the cited combination of references.

Further, Arakawa describes a surface roughening in the range of 2 to 10 microns (see Arakawa at col. 2, line 50). Thus, even if, arguendo, a person of the optical art decided to consult Arakawa, that person would be taught away from using Arakawa because the roughened surface of Arakawa, even applied on a transparent substrate, would be whitened due to irregular reflection thereon, which would make it improper for use as optical film.

In contrast, in the optical member of present claim 1, the protective film has an outer surface roughness Ra of from 0.03 to 1  $\mu\text{m}$ , as recited in present claim 1. An advantage of this feature is that this range of surface roughness permits visual inspection of the optical element, in particular the protective film. This feature of the presently claimed invention and its advantages are not taught in Arakawa or any of the other cited references, and therefore, claims 1-4 and 9-12 are not obvious over the cited references taken alone or in any combination.

In view of the above, it is submitted that the rejections should be withdrawn.

In conclusion, the invention as presently claimed is patentable. It is believed that the claims are in allowable condition and a notice to that effect is earnestly requested.

In the event there is, in the Examiner's opinion, any outstanding issue and such issue may be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Serial Number: 10/015,991

Group Art Unit: 2872

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of the response period. Please charge the fee for such extension and any other fees which may be required to our Deposit Account No. 50-2866.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Nicolas E. Seckel".

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